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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/186,475	11/04/98	FONG	A 238/046

022249
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SUITE 4700
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HM12/1127

EXAMINER	
UNGAR, S	
ART UNIT	**PAPER NUMBER**
1642	7

DATE MAILED: 11/27/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/186,475	Fong et al
Examiner	**Group Art Unit**
Ungar	1642

☒ Responsive to communication(s) filed on *Jan 27, 2000*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *one* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-3, 5-11, 15-24, and 27-32* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-3, 5-11, 15-24, and 27-32* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

.1. The Election filed January 27, 2000 (Paper No. 6) in response to the Office Action of December 20, 1999 (Paper No. 5) is acknowledged and has been entered. Claims 1-3, 5-11, 15-24 and 27-32 are pending in the application and are currently under prosecution.

2. .Applicant's election with traverse of Group II, claims 1-24 in Paper No 6 is acknowledged. The traversal is on the ground(s) that search of the inventions of Groups I and II would not impose a serious burden on the Examiner because it would not be unduly burdensome for the Examiner to search simultaneously for receptor agonists or receptor antagonists. The argument has been considered but has not been found persuasive because the literature search, particularly relevant in this art, is not coextensive. Different searches and issues are involved in the examination of each group. For these reasons the restriction requirement is deemed to be proper and is therefore made FINAL.

3. Upon review and reconsideration, Restriction to one of the following inventions is required under 35 U.S.C. § 121:

Group 1-286. Claims 1, 5-11, 15-24, 27-32 are drawn to a method for determining an efficacious dose for modulating angiogenesis wherein said compound is a receptor antagonist, wherein said receptor is Flt-1, wherein the antagonist is one of the eleven indolinone compounds, a-k delineated in claim 8, wherein the marker is one of the twenty-six markers delineated in claims 15-16, 22, 27 and 32 classified in class 435, subclass 4. Applicant is requied to elect one group including a single indolinone compound and a single

marker. Claims 17-21, 27 and 32 will be examined as they are drawn to the elected Group.

Group 287--572. Claims 1, 5-11, 15-24, 27-32 are drawn to a method for determining an efficacious dose for modulating angiogenesis wherein said compound is a receptor antagonist, wherein said receptor is Flk-1, wherein the antagonist is one of the eleven indolinone compounds, a-k delineated in claim 8, wherein the marker is one of the twenty-six markers delineated in claims 15-16, 22, 27 and 32 classified in class 435, subclass 4. Applicant is requied to elect one group including a single indolinone compound and a single marker. Claims 17-21, 27 and 32 will be examined as they are drawn to the elected Group.

Group 573-858. Claims 1-3, 5-11, 15-24, 27-32 are drawn to a method for determining an efficacious dose for modulating angiogenesis, wherein said angiogenesis is modulated to treat or prevent a condition manifested by cell proliferation, wherein said compound is a receptor antagonist, wherein said receptor is Flk-1, wherein the antagonist is one of the eleven indolinone compounds, a-k delineated in claim 8, wherein the marker is one of the twenty-six markers delineated in claims 15-16, 22, 27 and 32 classified in class 435, subclass 4. Applicant is requied to elect one group including a single indolinone compound and a single marker. Claims 3, 17-21, 27 and 32 will be examined as they are drawn to the elected Group.

Group 859-1144. Claims 1-3, 5-11, 15-24, 27-32 are drawn to a method for determining an efficacious dose for modulating angiogenesis, wherein said

angiogenesis is modulated to treat or prevent a condition manifested by cell differentiation, wherein said compound is a receptor antagonist, wherein said receptor is Flk-1, wherein the antagonist is one of the eleven indolinone compounds, a-k, delineated in claim 8, wherein the marker is one of the twenty-six markers delineated in claims 15-16, 22, 27 and 32 classified in class 435, subclass 4. Applicant is requied to elect one group including a single indolinone compound and a single marker. Claims 3, 17-21, 27 and 32 will be examined as they are drawn to the elected Group.

Group 1145-1430. Claims 1-3, 5-11, 15-24, 27-32 are drawn to a method for determining an efficacious dose for modulating angiogenesis, wherein said angiogenesis is modulated to treat or prevent a condition manifested by cell survival, wherein said compound is a receptor antagonist, wherein said receptor is Flk-1, wherein the antagonist is one of the eleven indolinone compounds, a-k, delineated in claim 8, wherein the marker is one of the twenty-six markers delineated in claims 15-16, 22, 27 and 32 classified in class 435, subclass 4. Applicant is requied to elect one group including a single indolinone compound and a single marker. Claims 3, 17-21, 27 and 32 will be examined as they are drawn to the elected Group.

Group 1431-1716. Claims 1-3, 5-11, 15-24, 27-32 are drawn to a method for determining an efficacious dose for modulating angiogenesis, wherein said angiogenesis is modulated to treat or prevent a condition manifested by cell proliferation, wherein said compound is a receptor antagonist, wherein said receptor is Flt-1, wherein the antagonist is one of the

eleven indolinone compounds, a-k, delineated in claim 8, wherein the marker is one of the twenty-six markers delineated in claims 15-16, 22, 27 and 32 classified in class 435, subclass 4. Applicant is requied to elect one group including a single indolinone compound and a single marker. Claims 3, 17-21, 27 and 32 will be examined as they are drawn to the elected Group.

Group 1717-2002. Claims 1-3, 5-11, 15-24, 27-32 are drawn to a method for determining an efficacious dose for modulating angiogenesis, wherein said angiogenesis is modulated to treat or prevent a condition manifested by cell differentiation, wherein said compound is a receptor antagonist, wherein said receptor is Flt-1, wherein the antagonist is one of the eleven indolinone twenty-six markers delineated in claims 15-16, 22, 27 and 32 classified in class 435, subclass 4. Applicant is requied to elect one group including a single indolinone compound and a single marker. Claims 3, 17-21, 27 and 32 will be examined as they are drawn to the elected Group.

Group 2003-2288. Claims 1-3, 5-11, 15-24, 27-32 are drawn to a method for determining an efficacious dose for modulating angiogenesis, wherein said angiogenesis is modulated to treat or prevent a condition manifested by cell survival, wherein said compound is a receptor antagonist, wherein said receptor is Flt-1, wherein the antagonist is one of the eleven indolinone compounds, a-k, delineated in claim 8, wherein the marker is one of the twenty-six markers delineated in claims 15-16, 22, 27 and 32 classified in class 435, subclass 4. Applicant is requied to elect one group including a

single indolinone compound and a single marker. Claims 3, 17-21, 27 and 32 will be examined as they are drawn to the elected Group

3. The inventions are distinct, each from the other because of the following reasons:

Inventions 1-2288 are materially distinct methods which differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Groups 1-2288 are further subject to election of a single disclosed species.

Claims 1 and 9 are generic to a plurality of disclosed patentably distinct species comprising samples which contain markers wherein the samples are selected from the group consisting of (a) whole blood, (b) a blood fraction/blood plasma, (c) blood fraction/blood serum, (d) blood fraction/cells isolated from blood, (e) whole urine, (f) urine fraction, (g) saliva, (h) cells isolated from saliva, (I) spinal fluid, (j) amniotic fluids, (k) biopsy of endothelial cells, all of claim 10.

6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable

over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

9. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

10. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this

Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (703) 305-2181. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995. The fax phone number for this Art Unit is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1642.

SUSAN UNGAR, PH.D
PRIMARY EXAMINER

Susan Ungar
Primary Patent Examiner
November 24, 2000

RESTRICTION ELECTION FACSIMILE TRANSMISSION

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IN COMPLIANCE WITH 1096-OG 30, THE FILING DATE ACCORDED EACH OFFICIAL FAX TRANSMISSION WILL BE DETERMINED BY THE FAX MACHINE DATE STAMP FOUND ON THE LAST PAGE OF THE TRANSMISSION, UNLESS THAT DATE IS A SATURDAY, SUNDAY, OR FEDERAL HOLIDAY WITHIN THE DISTRICT OF COLUMBIA, IN WHICH CASE THE OFFICIAL DATE OF RECEIPT WILL BE THE NEXT BUSINESS DAY.